

REMARKS

Claims 1-16 are pending in this application. By this Amendment, claims 1-7 and 10-16 are amended. Support for the amendments to the claims may be found, for example, in the claims as originally filed. No new matter is added.

In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

I. Rejection Under 35 U.S.C. §112, Second Paragraph

The Office Action rejects claims 1-16 under 35 U.S.C. §112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. By this Amendment, claims 1-7 and 10-16 are amended to overcome the rejection. Claims 8 and 9 each depend directly from claim 1. Claims 8 and 9 are not separately addressed by the rejection and, thus, Applicants respectfully submit that the amendments to claim 1 overcome the rejection as to claims 8 and 9. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

II. Rejection Under 35 U.S.C. §102

The Office Action rejects claims 1-15 under 35 U.S.C. §102(b) as anticipated by U.S. Patent Application Publication No. 2002/0037071 to Kohda ("Kohda"). Applicants respectfully traverse the rejection.

Kohda fails to disclose that "said fine particles functioning to block solar radiation comprise composite tungsten oxide fine particles expressed by the general formula $M_xW_yO_z$ where . . . the formula satisfies $0.001 \leq x/y \leq 1$, and $2.0 < z/y \leq 3.0$ " as required by claims 1 and 2. Kohda generally discloses powders containing 50% by weight or more of tungsten in relation to a scattered ray adsorption grid, which grid is unrelated to the laminated structures for shielding against solar radiation of claims 1 and 2. See, e.g., paragraphs [0010]-[0011].

Kohda discloses specific tungsten compounds at paragraph [0012]. However, the disclosed tungsten compounds of Kohda are not of "the general formula $M_xW_yO_z$ where . . . the formula satisfies $0.001 \leq x/y \leq 1$, and $2.0 < z/y \leq 3.0$." For example, Kohda discloses $MgWO_4$, $FeWO_4$ and $PbWO_4$, which do not satisfy $2.0 < z/y \leq 3.0$ as required by claims 1 and 2. See Kohda at paragraph [0012].

Thus, Kohda does not anticipate claims 1 and 2. Claims 3-13 and 15 depend from claim 1 and claim 14 depends from claim 2 and, thus, also are not anticipated by Kohda for at least the same reasons. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Rejection Under 35 U.S.C. §103

The Office Action rejects claims 1-16 under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,830,568 to Kondo ("Kondo"). Applicants respectfully traverse the rejection.

Kondo fails to teach or suggest that "said fine particles functioning to block solar radiation comprise composite tungsten oxide fine particles expressed by the general formula $M_xW_yO_z$ where . . . the formula satisfies $0.001 \leq x/y \leq 1$, and $2.0 < z/y \leq 3.0$ " as required by claims 1 and 2. The Office Action acknowledges that Kondo does not disclose composite tungsten oxide fine particles in accordance with the above formula. See p. 6.

Kondo discloses that:

. . . the functional ultrafine particles comprise at least one member selected from the group consisting of metals, compounds containing the metals, and composites containing the metals. These metals consist of Sn, Ti, Si, Zn, Fe, Al, Cr, Co, Ce, In, Ni, Ag, Cu, Pt, Mn, Ta, W, V and Mo. The compounds containing the metals consist of oxides of the metals, nitrides of the metals, oxynitrides of the metals, and sulfides of the metal. The composites containing the metals consist of the metals doped with at least one substance.

See col. 4, lines 13-23. That is, Kondo discloses that ultrafine particles can be selected from metals, compounds containing metals and composites containing metals in which tungsten

can be selected as the metal out of a laundry list of selectable metals. Id. Kondo is silent on any specific composite tungsten oxide fine particles, let alone, "composite tungsten oxide fine particles expressed by the general formula $M_xW_yO_z$ where . . . the formula satisfies $0.001 \leq x/y \leq 1$, and $2.0 < z/y \leq 3.0$."

There is no evidence that Kondo teaches or suggests the composite tungsten oxide fine particles of claims 1 and 2. In asserting that Kondo teaches or suggests the composite tungsten oxide fine particles of claims 1 and 2, Applicants respectfully submits that the Office Action fails to consider all claim limitations in evaluating obviousness. See MPEP §2143.03.

Even assuming for the sake of argument that Kondo discloses any and all composite tungsten oxide fine particles, no reason or rationale is set forth by the Office Action for why one of ordinary skill in the art would select the composite tungsten oxide fine particles of claims 1 and 2 out of the vast number of species encompassed within the genus of composite tungsten oxide fine particles in modifying Kondo. By ignoring this feature of the claims, Applicant respectfully submits that the Office Action fails to consider the claimed subject matter as a whole, as required. See MPEP §2141.02.

In other words, the Office Action cannot gloss over features of the claims with broad conclusory statements, such as:

. . . given the reasonable expectation of success, one having ordinary skill in the art at the time of the invention would have been motivated to utilize any tungsten oxide compound or composite oxide compound doped with the metals disclosed by Kondo, based upon the desired functional properties for a particular end use, wherein the claimed tungsten oxides are an obvious species of tungsten oxide utilized in the art.

See p. 6. By doing so, the Office Action fails to establish a *prima facie* case of obviousness because no reason or rationale for modifying Kondo to arrive at the subject matter of the claims is set forth and the subject matter of the claims as a whole is not considered. See MPEP § 2142.

In contrast, Applicants set forth reasons in the specification for selecting the composite tungsten oxide fine particles of claims 1 and 2. For example, the composite tungsten oxide fine particles of claims 1 and 2 produce a sufficient amount of free electrons that can produce an effective infrared blocking material and favorable adsorption characteristics in the near-infrared range in which the particles become effective as a near-infrared adsorption material at about a wavelength of 1000 nm. See the specification at p. 15, line 15 - p. 16, line 14; see also the specification, Examples 16-19 and 22.

Thus, Kondo would not have rendered obvious claims 1 and 2. Claims 3-13, 15 and 16 depend from claim 1 and claim 14 depends from claim 2 and, thus, also would not have been rendered obvious by Kondo for at least the same reasons. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of this application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:
Petition for Extension of Time

Date: December 22, 2008

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